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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,840	09/01/2000	James K. Beriker	254/180	5735

7590 02/02/2004

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EXAMINER

NGUYEN, DANG T

ART UNIT	PAPER NUMBER
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2178

11

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/653,840

Applicant(s)

BERIKER ET AL.

Examiner

Dang T Nguyen

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10. 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Application filed on 09/01/2000.
2. Claims 1 – 5 are pending in this case. Claim 1 is independent claim.
3. IDS filed on 9/1/2000. Some IDS documents do not include in the file, need request.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Ryan et al., U.S. patent No. 6,421,675 – filed Jul. 15, 1998.

Regarding independent claim 1, Figure 6 of Ryan discloses a method of generating a target list of customers comprising the steps of: (a) receiving a search criterion (Popular search select and keyword entry [272]) from a customer for producing search results ([274], Col. 21 lines 14-26). (b) obtaining and transmitting the search results to the customer ([278], Col. 21 lines 23-26); and (c) transmitting to the customer

an invitation to be included in the target list ([hit-list] Col. 6 lines 12-15) related to the search criterion (Col. 2 lines 28-31 and 50-56).

Regarding dependent claim 2, Ryan further discloses comprising the step of receiving from the customer an acceptance of invitation to be included in the target list (Col. 2 lines 26-31, and Col. 19 lines 39-48), the acceptance including contact information [web address] for the customer (Col. 19, lines 39-40).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan et al., U.S. Patent No. 6,421,675 B1, filed (07/15/98) in view of Pulliam et al., U.S. Patent No. 6,609,108 B1, filed (4/4/00).

Regarding dependent claims 3-5, Ryan et al. as applied to claims 1 and 2 above, further disclose adding the contact information to the target list related to the keyword (see Ryan et al., Fig. 17, shows Profile Ids (166) [Profile Ids 166 has a contact email] related to Keyword URL Links 172, and related to List of suggested web pages 604) except for

requesting confirmation using the contact information and receiving a confirmation of the acceptance from the customer.

Pulliam et al. teaches online communication schema having requesting and receiving confirmation (see Abstract and Col. 3 lines 29-51). Ryan and Pulliam are analogous because they are related to search engine; therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have incorporated Pulliam's confirmation into Ryan's target list of keyword for the purpose of providing the availability of status and tracking information (see Col. 2 lines 47-48).

Prior art

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hoekstra	Patent No. US 5,905,862	Date of Patent: May. 18, 1999
Ohkura et al.	Patent No. US 5,867,700	Date of Patent: Feb. 2, 1999
Yokell et al.	Patent No. US 6,507,870 B1	Date of Patent: Jan. 14, 2003
Call	Patent No. US 6,154,738	Date of Patent: Nov. 28, 2000

Contact Information

7. Any inquiry concerning this communication from the examiner should be directed to Dang Nguyen, who can be reached by telephone at (703) 305-1673. Normal contact times are M-F, 8-4:30.

Upon an unsuccessful attempt to contact the examiner, the examiner's supervisor, Stephen Honh, may be reached at (703) 308-5465.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 746-7239 (for formal communications intended for entry)

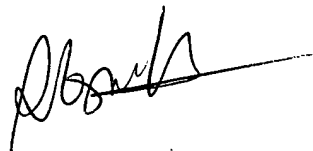
or:

(703) 746-7238 (for after-final communications)

Hand-delivered responses should be brought to

Crystal Park II, 2121 Crystal Drive
Arlington, VA, Fourth Floor (receptionist).

Dang Nguyen 1/22/2003


STEPHEN S. HONG
PRIMARY EXAMINER